

Appl. No.: 10/051,938  
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### REMARKS

Claims 38-40, 43, 46-48, 52-56, 59, 62-64, 67-70, 73 and 76-84 are currently pending in the present application.

#### Rejection Under 35 U.S.C. §112, 1<sup>st</sup> Paragraph & Related Objection to the Specification:

In Paper No. 7, the Examiner maintains the rejection of claims 46-48, 62-64 and 76 under 35 U.S.C. §112, first paragraph, as containing subject matter which is not described in the Specification in such a way as to convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner continues to contend that the claims requiring a mixture of a monocarboxylic acid and a dicarboxylic acid constitute new matter which is not supported by Applicant's Specification. In response to Applicant's previous remarks submitted on October 8, 2002, the Examiner argues that the "disclosure (including the incorporation by reference) does not disclose the claimed combination of a mixture of monocarboxylic and dicarboxylic acids . . . ." (See, Paper No. 7, p.5). In Paper No. 7, the Examiner also maintains the objection to the Specification as lacking antecedent basis for the claimed subject matter. Applicant strenuously, but respectfully, traverses this rejection and the accompanying objection for the following reasons.

Applicant's Specification, as filed, includes the following text,

The carboxylic acid components of the polyol esters according to the invention are aliphatic carboxylic acids having from 5 to 18 carbon atoms. Thus, the polyol esters suitable for use in the shock absorbers according to the invention are hindered polyol esters of C<sub>5-18</sub> carboxylic acids. The C<sub>5-18</sub> carboxylic acids can be linear or branched and are preferably linear. The esters according to the invention can be made by the method described in U.S. patent 5,021,179, the entire contents of which are incorporated herein by reference. The final formulated shock absorber fluid will contain individual hindered polyol esters of C<sub>5-18</sub> carboxylic acids or combinations of 2 or more of such esters and will also typically contain antioxidants, corrosion inhibitors, antiwear additives and seal conditioners.  
(See, Applicant's Specification, p. 3, lines 16-26, (*emphasis added*)).

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Applicant once again reiterates that the incorporation by reference set forth in the above-cited portion of the Specification is both allowable and acceptable in accomplishing the same thing as if the actual text of the incorporated patent had been set forth in the Specification in its entirety.

The M.P.E.P. clearly states:

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. (M.P.E.P., §2163.07(b), 8<sup>th</sup> Ed. (*emphasis added*)).

The rules for incorporation by reference are more specifically provided for in Chapter 600 of the M.P.E.P., wherein it provides:

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). (M.P.E.P., §608.01(p)).

Accordingly, Applicant submits that the incorporation of U.S. Pat. No. 5,021,179, by reference in the instant Specification is fully compliant with Title 35, §112, and the rules, as further described in the M.P.E.P. **Thus, Applicant submits that the entire contents of U.S. Pat. No. 5,021,179 are part of the original disclosure of the instant application.**

**If the Examiner disagrees, and it is the Examiner's position that Applicant's incorporation by reference is somehow defective for any reason, then Applicant respectfully requests that the Examiner specifically identify the reason(s) for such a determination so that these reasons can be properly addressed on appeal.**

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Assuming the Examiner understands and accepts the legality and effect of Applicant's incorporation by reference, it should then be noted that column 3, lines 22-39 of U.S. Pat. No. 5,021,179 ("the '179 patent"), specifically, lines 24-26, contains disclosure of certain esters wherein it is preferred, "to react a single kind of alcohol [] with a mixture of monovalent and divalent acids . . ." (See, the '179 patent, col. 3, lines 22-39). This is a clear description of esters based upon mixtures of monocarboxylic (*i.e.*, monovalent) and dicarboxylic (*i.e.*, divalent) acids. Mixtures of monocarboxylic acids and dicarboxylic acids are described specifically, and broadly, throughout the '179 patent, for example, at col. 3, lines 4-10, lines 40-41, and at col. 4, lines 13-25. The '179 patent states,

For higher viscosity ranges, *some divalent acyl groups* are preferred, as it is believed that esters containing two or more alcohol moieties *joined by such divalent acyl groups*, with all the other hydroxyl positions on the alcohols corresponding to the esterified by monoacyl groups, are particularly advantageous types of esters for use according to this invention.

(See, the '179 patent, col. 3, lines 4-10 (*emphasis added*)).

The '179 patent also specifically states that, "[w]hether the acids used for esterification are all monovalent or contain some acids of higher valency, reaction between the alcohol(s) used and the acid(s) has been found to proceed more effectively if the quantity of acid charged to the reaction mixture initially is . . . an excess . . ." (See, the '179 patent, col. 3, lines 40-47 (*emphasis added*)). Finally, the '179 patent also discloses that, "[a]n independent constraint on the ratio between monovalent and higher valency acids to be reacted is that too large a fraction of acids with more than one valence may result in an undesirable amount of high molecular weight polymer, in view of the fact that all or substantially all of the alcohol(s) to be reacted also have at least two reactive groups. For this reason, it is increasingly preferred that the ratio of equivalents from monovalent acids to the equivalents from *divalent or higher valent acids* reacted be at least 1, 1.76, or 2.69. Also, the amount of acyl groups with a valence higher than 2 preferably is no more than 2 no. % of the total of all acyl groups." (See, the '179 patent, col. 4, lines 13-25 (*emphasis added*)).

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Applicant submits that a carboxylic acid component containing both monocarboxylic and dicarboxylic acid constituents is fully supported by the disclosure in the instant application, including the incorporation of the '179 patent by reference.

**If the Examiner does not agree that the cited portions of the '179 patent, which constitute part of the original disclosure of the instant application, disclose the use of mixtures of monocarboxylic and dicarboxylic acids in the preparation of the subject polyol esters, Applicant respectfully requests that the Examiner at least provide some rationale or explanation as to how the cited portions of the '179 patent fail to disclose such information.**

Finally, with respect to the rejection under §112, first paragraph, Applicant respectfully submits that the Specification, as filed, contained original claims which recite esters based upon a mixture of carboxylic acids having from 5 to 9 carbon atoms. (*See, e.g.*, Applicant's Specification, original claims 6, 8, 15, 17 and 26). As the Examiner is aware, the claims are as much a part of the disclosure as any other portion of the Specification. Thus, support for a mixture of two or more acids having a carbon chain length of from 5 to 9 carbon atoms is fully supported by the disclosure. Moreover, support for the biodegradability of the polyol esters of the present invention is clearly set forth in the Specification, for example, at page 3, lines 27-31.

Accordingly, Applicant submits that the claims are fully supported by the original disclosure in the instant application, and that no new matter has been introduced into the claims. Thus, reconsideration and withdrawal of both the rejection under 35 U.S.C. §112, first paragraph and the objection to the Specification are requested.

**Rejection Under 35 U.S.C. §103(a) Over Duncan and Funkhouser:**

In Paper No. 7, the Examiner maintains the rejection of claims 38-40, 43, 52, 54-56, 59, 67-70, 73, 77-78 and 81-84 under 35 U.S.C. §103(a), as being unpatentable over U.S. Pat. No. 5,681,800 of Duncan, *et al.* ("Duncan"), in view of U.S. Pat. No. 2,630,193 of Funkhouser ("Funkhouser"). The Examiner contends that Applicant's claimed invention is obvious in view of a standard shock absorber disclosed in Funkhouser, taken in conjunction with the polyol ester of Duncan's Table 8, *i.e.*, the "TPE/C810/Ck8" ester, which, according to the

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Examiner's contentions, contains a carboxylic acid component that is a blend of linear C6 and C8 acids.

Applicant respectfully traverses this rejection and the arguments and contentions in support thereof for the following reasons.

First, Duncan discloses the use of linear carboxylic acids blended with branched acids, and exemplifies the use of a "C810" linear acid component. "C810 denotes predominantly a mixture of *n*-octanoic and *n*-decanoic acids, and may include small amounts of *n*-C<sub>6</sub> and *n*-C<sub>12</sub> acids." (See, Duncan, Table 1, notes). There is no teaching that the "C810" component does in fact contain a mixture as claimed or that it should contain such a mixture, only a notation that the product might have other acids present.

Second, there is no teaching or suggestion that the presence of the possible C<sub>6</sub> acid is beneficial in any use, much less the specific use as a dampening fluid. There is no indication that the use of a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids would be beneficial. Nothing suggests that a C810 component which does contain a C<sub>6</sub> acid is better or should be used to obtain polyol esters which are more biodegradable or have better dampening capabilities. Furthermore, Duncan is primarily concerned with the combination of linear and branched acids to achieve its alleged results.

Third, given the lack of any teaching that requires a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids, the lack of any benefit associated with such a mixture, and the focus on the presence of branched acids along with the linear C810 component, one of ordinary skill in the art would not have a reasonable expectation of success, nor would one be inclined to seek out and use mixtures as claimed by Applicant.

Accordingly, Applicant submit that the Examiner has failed to establish a *prima facie* case of obviousness based upon the combined Duncan and Funkhouser references. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

In view of the remarks set forth above, Applicant submits that all pending claims fully comply with the requirements of 35 U.S.C. §112, first paragraph, and that all pending claims patentably distinguish over the prior art of record and known to Applicant, either alone or

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in combination. Accordingly, reconsideration, withdrawal of the rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,

**EUGENE R. ZEHLER**

By: 

AARON R. ETTELMAN

Registration No. 42,516

**COGNIS CORPORATION**

2500 Renaissance Blvd., Suite 200

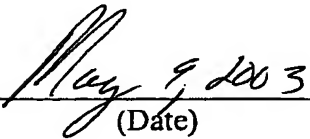
Gulph Mills, PA 19046

Telephone: (610) 278-4930

Facsimile: (215) 278-4971

E-Mail: AARON.ETTELMAN@COGNIS-US.COM

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(Date)